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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/747,676	12/30/2003	Roy Ben-Yoseph	06975-539001	2911
26171 7590 09/21/2007 FISH & RICHARDSON P.C. P.O. BOX 1022 MINNEAPOLIS, MN 55440-1022			EXAMINER TAHA, SHAQ	
			ART UNIT 2146	PAPER NUMBER
			MAIL DATE 09/21/2007	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	Application No.	Applicant(s)	
	10/747,676	BEN-YOSEPH, ROY	
	Examiner	Art Unit	
	shaq taha	2146	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 30 December 2003.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1 - 55 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1 - 55 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>4/5/2004, 3/28/2005, 2/23/2007</u> .                          | 6) <input type="checkbox"/> Other: _____                          |

## DETAILED ACTION

The instant application having Application No. 10/747,676 has a total of 55 claims pending in the application; there are 3 independent claims and 52 dependent claims, all of which are ready for examination by the examiner.

### **Claim Rejections - 35 USC § 102**

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

Claims 1-7, 9-17, 19-34, 36-44, and 46-55 are rejected under 35 U.S.C. 102(e) as being anticipated by Dieterman et al (US 6,393,464).

- Regarding claim 1, Dieterman teaches a method comprising: maintaining a list of people known to a user, **[The method utilizes a list of allowed electronic addresses with whom the user is permitted to freely exchange messages, (Column 2, lines 1 - 3)];**  
inferring that a person is associated with the user based, at least in part, on interactions between the user and a received message, **[Each message sent by or sent to the user will be categorized as either authorized if the other party to**

**the communication appears on the allowed list, or unauthorized if the other party does not appear on the allowed list, (Column 2, lines 3 – 6)];**

**adding the inferred person to the list, [the administrator may view the content of the allowed list and add, delete and edit the identities of entities appearing on the allowed list, (Column 3, lines 53 – 57)];**

**and using the list to control aspects of communications between the user and others based on whether the others are included on the list, [However, electronic entity identifications can include any identifying means by which another party can be communicated with, (Column 3, lines 59 – 62)].**

- Regarding claim 2, Dieterman teaches the method wherein the received message is an e-mail message received from the person, **[Fig. 2, Ref # 17]**.
- Regarding claim 4, Dieterman teaches the method wherein interactions include moving the e-mail from a first folder to a second folder, **[Fig. 9, (outbox), Fig. 10, (inbox)]**.
- Regarding claim 5, Dieterman teaches the method wherein the first folder is an inbox folder and the second folder is a folder other than a delete folder or a spam folder, **[Fig. 9, (outbox), Fig. 10, (inbox)]**.

Art Unit: 2146

- Regarding claim 6, Dieterman teaches the method wherein the interactions include maintaining the e-mail received from the person in an open state for a predetermined period of time, **[If approval is not given, step 60, the message will be deleted after a predetermined amount of time, (Column 5, lines 44 - 46)]**.
- Regarding claim 7, Dieterman teaches the method further comprising inferring that a person is associated with the user based, at least in part, on the user sending a message to the person, **[almost anyone with a computer can communicate with other computer users to send and receive messages, (Column 1, lines 12 – 15)]**.
- Regarding claim 9, Dieterman teaches the method further comprising inferring that a person is associated with the user based, at least in part, on indicia other than actions performed by the user, **[The user will receive an indication that the administrator must approve the e-mail before it will be sent, (Column 2, lines 11 - 13)]**;  
wherein inferring based on indicia other than actions performed by the user comprises: accessing a contact list of the user to determine a first contact on the user's contact list, **[Fig. 7]**;  
and accessing a contact list of the first contact to determine a second contact on the first contact's contact list, **[Fig. 8]**.

- Regarding claim 10, Dieterman teaches the method further comprising inferring that a person is associated with the user based, at least in part, on detecting user actions that mitigate against factors that otherwise are used to infer a person is associated with the user, **[a method for controlling the delivery of electronic messages sent to and sent by a user. Specifically, the method comprises the steps of: creating an allowed list comprised of electronic entity identifications with whom the user is permitted to freely exchange messages, (Column 2, lines 20 – 25)].**
- Regarding claim 11, Dieterman teaches the method wherein the user actions comprise the user taking steps to report a communication from the person as spam, **[Fig. 6, Ref # 88].**
- Regarding claim 12, Dieterman teaches the method wherein the user actions comprise the user taking steps to add a person to a blacklist, **[Fig. 2, Ref # 15, 16, 17].**
- Regarding claim 13, Dieterman teaches the method wherein the user actions comprise the user taking steps to move a communication from the person to at least one of a spam folder or a delete folder, **[Fig. 4, Ref # 77].**

- Regarding claim 14, Dieterman teaches the method wherein people associated with the user are people not distrusted by the user, **[Each message sent by or sent to the user will be categorized as either authorized if the other party to the communication appears on the allowed list, (Column 2, lines 3 – 6)]**.
- Regarding claim 15, Dieterman teaches the method wherein using the list comprises using the list as a white list such that communications received from people on the list are exempt from spam filtering, **[Outgoing messages which are authorized will be transmitted to their destination, and incoming messages which are authorized can be opened and viewed by the user, (Column 2, lines 7 – 10)]**.
- Regarding claim 16, Dieterman teaches the method wherein using the list comprises using the list to restrict received communications to those communications from people on the list, **[Each message sent by or sent to the user will be categorized as either authorized if the other party to the communication appears on the allowed list, (Column 2, lines 3 – 6)]**.
- Regarding claim 17, Dieterman teaches the method wherein the communications are e-mails, **[Fig. 2, Ref # 17]**.

- Regarding claim 19, Dieterman teaches the method wherein people associated with the user are people known to the user, **[Each message sent by or sent to the user will be categorized as either authorized if the other party to the communication appears on the allowed list, (Column 2, lines 3 – 5)]**.
- Regarding claim 20, Dieterman teaches the method wherein using the list comprises using the list to filter a display of e-mail such that e-mails from people on the list are shown on the display and e-mails from people not on the list are absent from the display, **[Fig. 2, a client email terminal device screen display which allows an administrator to create, view and edit a list of allowed email addresses with whom the user may exchange email messages,(Column 2, lines 51 – 53)]**.
- Regarding claim 21, Dieterman teaches the method wherein using the list comprises using the list to filter a display of e-mail such that e-mails from people not on the list are shown on the display and e-mails from people on the list are absent from the display, **[Fig. 2, a client email terminal device screen display which allows an administrator to create, view and edit a list of allowed email addresses with whom the user may exchange email messages,(Column 2, lines 51 – 53)]**.



- Regarding claim 22, Dieterman teaches the method wherein using the list comprises using the list to restrict which instant messaging interfaces display an online presence of the user to those instant messaging interfaces associated with people on the list, **[Fig. 2, a client email terminal device screen display which allows an administrator to create, view and edit a list of allowed email addresses with whom the user may exchange email messages,(Column 2, lines 51 – 53)]**.
- Regarding claim 23, Dieterman teaches the method wherein using the list comprises using the list as a white list operating in conjunction with parental controls to filter communications from people not on the list when the communications include indicia that the content of the communication is inappropriate for a teen or child account user, **[a parent at work can use any computer with internet access to add, delete, or change the list people with whom their child can communicate, (Column 6, lines 46 – 50)]**.
- Regarding claim 24, Dieterman teaches the method wherein filtering communications comprises blocking the communications from people not on the list when the communications include indicia that the content of the communication is inappropriate for a teen or child account user, **[Outgoing messages which are not authorized will not be transmitted, but rather will**

**be held. The user will receive an indication that the administrator must approve the e-mail before it will be sent, (Column 2, lines 8 – 13)].**

- Regarding claim 25, Dieterman teaches the method wherein filtering communications comprises placing communications from people not on the list in a spam folder the communications include indicia that the content of the communication is inappropriate for a teen or child account user, **[Outgoing messages which are not authorized will not be transmitted, but rather will be held. The user will receive an indication that the administrator must approve the e-mail before it will be sent, (Column 2, lines 8 – 13)].**
- Regarding claim 26, Dieterman teaches the method wherein the spam folder is locked from the teen or child account user, **[incoming e-mails which are not sent by an entity whose address appears in the list of allowed addresses, cannot be opened or read by the user. The user will be prompted to seek approval of the incoming message from the administer, (Column 2, lines 13 – 18)].**
- Regarding claim 27, Dieterman teaches the method wherein the communications are e-mails, **[Fig. 2, Ref # 17].**

- Regarding claim 28, Dieterman teaches a computer usable medium having a computer program embodied thereon, wherein the computer program comprises instructions for causing a computer to perform the following operations: maintain a list of people known to a user; infer that a person is associated with the user based, at least in part, on interactions between the user and a received message; add the inferred person to the list; and use the list to control aspects of communications between the user and others based on whether the others are included on the list, **(Same as claim #1 above)**.
- Regarding claim 29, Dieterman teaches the method wherein the received message is an e-mail message received from the person, **[Fig. 2, Ref # 17]**.
- Regarding claim 30, Dieterman teaches wherein the interactions include replying to, forwarding, saving, or printing the e-mail message received from the person.
- Regarding claim 31, Dieterman teaches the method wherein the interactions include moving the e-mail from a first folder to a second folder, **[Fig. 9, (outbox), Fig. 10, (inbox)]**.
- Regarding claim 32, Dieterman teaches the method wherein the first folder is an inbox folder and the second folder is a folder other than a delete folder or a spam folder, **[Fig. 9, (outbox), Fig. 10, (inbox)]**.

- Regarding claim 33, Dieterman teaches the method wherein the interactions include maintaining the e-mail received from the person in an open state for a predetermined period of time, **[If approval is not given, step 60, the message will be deleted after a predetermined amount of time, (Column 5, lines 44 - 46)]**.
- Regarding claim 34, Dieterman teaches the medium wherein the computer program further comprises instructions for causing a computer to infer that a person is associated with the user based, at least in part, on the user sending a message to the person, **[almost anyone with a computer can communicate with other computer users to send and receive messages, (Column 1, lines 12 – 15)]**.
- Regarding claim 36, Dieterman teaches the medium wherein the computer program further comprises instructions for causing a computer to infer that a person is associated with the user based, at least in part, on indicia other than actions performed by the user, wherein, to infer based on indicia other than actions performed by the user, the computer program further comprises instructions for causing a computer to: access a contact list of the user to determine a first contact on the user's contact list; and access a contact list of the

first contact to determine a second contact on the first contact's contact list,  
**(Same as claim # 9 above)]**.

- Regarding claim 37, Dieterman teaches the medium wherein the computer program further comprises instructions for causing a computer to infer that a person is associated with the user based, at least in part, on detecting user actions that mitigate against factors that otherwise are used to infer a person is associated with the user, **(Same as claim # 10 above)**.
- Regarding claim 38, Dieterman teaches the medium wherein the user actions comprise the user taking steps to report a communication from the person as spam, **(Same as claim # 11 above)**.
- Regarding claim 39, Dieterman teaches the method wherein the user actions comprise the user taking steps to add a person to a blacklist, **(Same as claim # 12 above)**.
- Regarding claim 40, Dieterman teaches the medium wherein the user actions comprise the user taking steps to move a communication from the person to at least one of a spam folder or a delete folder, **(Same as claim # 13 above)**.

- Regarding claim 41, Dieterman teaches the medium wherein people associated with the user are people not distrusted by the user, **(Same as claim # 14 above)**.
- Regarding claim 42, Dieterman teaches the medium wherein, to use the list, the computer program further comprises instructions for causing a computer to use the list as a white list such that communications received from people on the list are exempt from spam filtering, **(Same as claim # 15 above)**.
- Regarding claim 43, Dieterman teaches the medium wherein, to use the list, the computer program further comprises instructions for causing a computer to use the list to restrict received communications to those communications from people on the list, **(Same as claim # 16 above)**.
- Regarding claim 44, Dieterman teaches the medium wherein the communications are e-mails, **[Fig. 2, Ref # 17]**.
- Regarding claim 46, Dieterman teaches the medium wherein people associated with the user are people known to the user, **(Same as claim # 19 above)**
- Regarding claim 47, Dieterman teaches the medium wherein, to use the list, the computer program further comprises instructions for causing a computer to use the list to filter a display of e-mail such that e-mails from people on the list are

shown on the display and e-mails from people not on the list are absent from the display, **(Same as claim # 20 above)**.

- Regarding claim 48, Dieterman teaches the medium wherein, to use the list, the computer program further comprises instructions for causing a computer to use the list to filter a display of e-mail such that e-mails from people not on the list are shown on the display and e-mails from people on the list are absent from the display, **(Same as claim # 21 above)**.
- Regarding claim 49, Dieterman teaches the medium wherein, to use the list, the computer program further comprises instructions for causing a computer to use the list to restrict which instant messaging interfaces display an online presence of the user to those instant messaging interfaces associated with people on the list, **(Same as claim # 22 above)**.
- Regarding claim 50, Dieterman teaches the medium wherein, to use the list, the computer program further comprises instructions for causing a computer to use the list as a white list operating in conjunction with parental controls to filter communications from people not on the list when the communications include indicia that the content of the communication is inappropriate for a teen or child account user, **(Same as claim # 23 above)**.

- Regarding claim 51 Dieterman teaches the medium wherein, to filter communications, the computer program further comprises instructions for causing a computer to block the communications from people not on the list when the communications include indicia that the content of the communication is inappropriate for a teen or child account user, **(Same as claim # 24 above)**
- Regarding claim 52 Dieterman teaches the medium wherein, to filter communications, the computer program further comprises instructions for causing a computer to place communications from people not on the list in a spam folder the communications include indicia that the content of the communication is inappropriate for a teen or child account user, **(Same as claim # 25 above)**
- Regarding claim 53 Dieterman teaches the medium wherein the spam folder is locked from the teen or child account user, **(Same as claim # 26 above)**.
- Regarding claim 54 Dieterman teaches the medium wherein the communications are e-mails, **[Fig. 2, Ref # 17]**.
- Regarding claim 55, Dieterman teaches an apparatus comprising: means for maintaining a list of people known to a user, means for inferring that a person is associated with the user based, at least in part, on interactions between the user and a received message, means for adding the inferred person to the list, and



means for using the list to control aspects of communications between the user and others based on whether the others are included on the list, **(Same as claim # 1 above)**.

**Claim Rejections - 35 USC § 103**

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims are rejected under 35 U.S.C. 103(a) as being unpatentable over Dieterman et al. (US 6,393,464) as applied to claims 1 above, and further in view of Tucciarone et al. (US 2003/0009385).

- Regarding Claims 8, 18, 35 and 45 Dieterman teaches the method according to claim 1, as described above. Dieterman further teaches a method for controlling the delivery of electronic mail, **(See Abstract)**.

Dieterman et al. differs from the claimed invention is that the communications are instant messages is not taught in Dieterman et al.

Tucciarone teaches a method on-request service precluding unwanted solicitation of electronic messages, **(See Abstract)**, and further teaches that provide such information by e-mail or alternate e-messaging protocol, e.g., instant messaging, **( Paragraph 0016 )**. Tucciarone provides the advantage of that the communications are instant messages.

It would have been obvious to one of ordinary skill in the art at the time of the invention was made to modify Dieterman by including instant messages as communications as taught by Tucciarone.

One of ordinary skill in the art would have been motivated to make this Modifications in order to provide the advantage of communications are instant messages.

- Regarding claim 3, Tucciarone teaches the method wherein the interactions include replying to, forwarding, saving, or printing the e-mail message received from the person, **[the user's specific behaviors(open/save/delete/forward/et al.) in response to a given e-mail received, (Paragraph 0010)]**.

### **Conclusion**

The following prior art made of record and not relied upon is cited to establish the level of skill in the applicant's art and those arts considered reasonably pertinent to applicant's disclosure. See **PEP 707.05(c)**.

The following are analogous art because they are from the same field of endeavor of Identifying and using identities deemed to be known to a user:

- Ingerman et al. Paten US Pub No: (US 2004/0255122 A1)
- Lewis et al. US Pub No: (US 20030110212)
- Zhu et al. Patent No: (US 7,181,498)
- Skalecki et al. Patent No: (US 6,195,354)
- Evans et al. US Pub No: (US 2005/0198173 A1)
- Tucciarone et al. US Pub No: (US 2003/0009385 A1)
- Bhatia et al. US Pub No: (US 2005/0160144 A1)
- Bulfer et al. US Pub No: (US 2006/0036701 A1)

Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Shaq Taha** whose telephone number is 571-270-1921.

The examiner can normally be reached on 8:30am-5pm Mon-Fri.

Art Unit: 2146

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, **Jeff Put** can be reached on 571-272-6798.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

9/13/07

S. Taha



JEFFREY PWU  
SUPERVISORY PATENT EXAMINER